



COPY OF PAPER  
ORIGINALLY FILED

Attorney's Docket No.: 75-275001 / LDSG/Z70655/US

#11  
Electron

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : John Craig Smith  
Serial No. : 09/773,599  
Filed : February 2, 2001  
Title : DIAGNOSTIC METHOD

Art Unit : 1634  
Examiner : Juliet C. Einsmann

Commissioner for Patents  
Washington, D.C. 20231

RECEIVED  
JUL 26 2002  
TECH CENTER 1600/2900

RESPONSE TO RESTRICTION REQUIREMENT

Responsive to the action mailed May 13, 2002, applicant elects the invention of Group I and further elects the single nucleotide polymorphism at position 33251 of the reverse complement of EMBL Accession Number AC006953. This polymorphism is represented by SEQ ID NO:4. This election is made with traverse.

First, Applicants point out that all of the polymorphisms specified in the claims relate to a single gene and its encoded protein, uPAR. It is not clear from the language of the restriction requirement that the Examiner appreciated this fact. For example, see page 3, line 8, where the Examiner stated that the various polymorphic sequences are "unrelated". When the gene is viewed as a whole, the various polymorphisms are of course highly related. Furthermore, from a practical standpoint, a single search will reveal the art relevant to all of these polymorphisms, including the methods of detecting them. Thus, there would certainly not be an undue burden on the examiner to search all eight nucleotide polymorphisms and two amino acid residue polymorphisms, as well as all methods of detecting them.

Second, the restriction between a given nucleotide polymorphism and its corresponding amino acid residue polymorphism seems particularly unwarranted. The polymorphism at nucleotide position 33251 of the reverse complement of EMBL Accession Number AC006953 corresponds to the polymorphism at amino acid residue 198 of the uPAR protein; i.e., anyone

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

Date of Deposit

July 15, 2002

Signature

Joanne D. Boyle

Joanne D. Boyle

Typed or Printed Name of Person Signing Certificate

Applicant : John Craig Smith  
Serial No. : 09/773,599  
Filed : February 2, 2001  
Page : 2

Attorney's Docket No.: 06275-  
275001 / LDSG/Z70655/US

with a polymorphism at residue 198 will also have a polymorphism at nucleotide position 332521. Thus, a search that encompasses one will be adequate to cover the other. The same is true of nucleotide position 36623 and amino acid residue 295. Again, there is no burden on the examiner to search the polymorphism at both the nucleic acid and the amino acid levels. It would seem odd to separate them.

Third, Applicant notes that both groups I and II are classified in class 435, while groups IV, V, and VI are all in class 424. It would appear that groups I and II can be efficiently searched together, and likewise groups IV, V, and VI.

Finally, applicant points out that claim 1 covers determining the sequence "at one or more" of the eight nucleotide positions and two amino acid residue positions. If the restriction requirement is allowed to stand, it will limit applicant to claiming a method of determining the sequence at only a single one of the ten positions. The restriction requirement ignores those embodiments of the claims in which the sequence at two, three, four, five, six, seven, eight, nine or all ten positions is determined. It essentially prohibits applicants from presenting such claims, in this application or any divisional.

Applicants strongly protest and request withdrawal of the restriction requirement.

Enclosed is an Associate Power of Attorney granting Power of Attorney to the undersigned and requesting that future communications be direct to the undersigned. Also enclosed is a Petition for Extension of Time for one month and a check for the required fee of \$110. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date:

July 15, 2002

Janis K. Fraser, Ph.D., J.D.  
Reg. No. 34,819

Fish & Richardson P.C.  
225 Franklin Street  
Boston, Massachusetts 02110-2804  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906